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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor : Jan Weber	Group Art Unit: 3737
Appln. No.: 10/007,284	Examiner: Shawna J. Shaw
Filed : November 9, 2001	
For : CERAMIC REINFORCEMENT MEMBERS FOR MRI DEVICES	
Docket No.: S13.12-0125	

RESPONSE

Box Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed on November 26, 2003, which included a three-way restriction requirement. The applicant elects group II of the claims for examination, including claims 11-20 according to the Office's designation. The applicant also traverses the restriction requirement specifically as to each distinction among groups I, II and III, and in light of the following remarks, respectfully invites the Office to reconsider these restrictions and to examine all three groups together; or in the alternative, to examine group III together with group II; or in the alternative, to examine group II while allowing group III to be examined together with group I in a separate divisional application claiming priority from the present application; and in the alternative, to examine group I together with group II.

GROUPS II AND III SHOULD BE EXAMINED AS A SINGLE INVENTION

Group II is drawn to an elongated medical device for intravascular manipulation during magnetic resonance imaging of body tissue, comprising certain elements as defined by claim 11

and further elements in each of claims 12-20. Group III is drawn to a reinforcement member for reinforcing an elongated intravascular magnetic resonance imaging device, the reinforcement member comprising certain elements as defined by claim 21 and further elements in each of claims 22-28.

As noted in the recent Office action, restriction is proper between a combination and a subcombination if (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) the subcombination has utility by itself or in other combinations. It was suggested in the Office action that these requirements were met because the combination as claimed does not require the particulars of the subcombination as claimed because it does not require a coating disposed around the elongated ceramic fiber, and that the subcombination has separate utility such as reinforcing devices for non-magnetic resonance imaging.

However, claim 21 reads in part, "A reinforcement member for reinforcing an elongated intravascular magnetic resonance imaging device..." (emphasis added). Therefore, the claim is defined in terms of serving for reinforcing a magnetic resonance imaging device, and as further defined by the language of the claims. The suggestion in the Office action that group III has separate utility for reinforcing devices for non-magnetic resonance imaging contradicts the claim language defining a "reinforcement member for reinforcing an elongated intravascular magnetic resonance imaging device..." The applicant therefore requests that this contradictory assertion be reconsidered and withdrawn, and that group III be found not to have separate utility from group II. Correspondingly, the applicant respectfully requests that groups II and III, comprising claims 11-28, be considered and examined as a single invention.

GROUPS I AND II SHOULD BE EXAMINED AS A SINGLE INVENTION

The applicant also traverses the restriction requirement between groups I and II. The applicant requests that the restriction between groups I and II be reconsidered and withdrawn along with the restriction requirement between groups II and III, so that these three groups may all be examined together in the present application. The restriction between groups I and II was based in part on the asserted separate utility of the subcombination of group I, such as for reinforcing devices for localized imaging of a body portion. However, this asserted requirement is not found in the claim language that defines group I. The applicant has been given no indication of the hypothetical source of this asserted separate utility, and therefore no way to make a reasoned response to this assertion.

The applicant therefore respectfully submits that no basis has been indicated to properly derive a separate utility of the subcombination of group I from the utility of the combination group II. The applicant therefore requests that the restriction of group I from group II be reconsidered and the claims of group I be examined together with the claims of group II (as well as group III, as per the remarks above). In the alternative, if the restriction requirement between groups II and I is not withdrawn after reconsideration, the applicant nevertheless believes that withdrawing the restriction between groups II and III and examining these groups together would be proper, and respectfully requests this action to be taken.

GROUPS I AND III SHOULD BE EXAMINED AS A SINGLE INVENTION

In the alternative, if group III is still found to be distinct from group II after reconsideration, the applicant nevertheless elects group II for examination in the present application, but also requests that the restriction between groups I and III be reconsidered, and that these groups be found

to be a single invention for purposes of a separate divisional application claiming priority from the present invention. Groups I and III were found distinct in the recent Office action based only on the assertion that "In the instant case, invention III has separate utility such as reinforcing devices for non-magnetic imaging." It was not asserted in the Office action that the combination of group I has separate utility from group III. Only the separate utility of the group III subcombination was asserted in this Office action, without a corresponding assertion that the group I subcombination as claimed has separate utility. Therefore, the Office action does not meet the burden of producing a rationale for both of the twofold prima facie requirements for imposing a restriction requirement between the two subcombination groups, of indicating the separate utility of each of the two subcombinations apart from the other; see MPEP §806.05(d). Therefore, the applicant requests that the restriction requirement between groups I and III be reconsidered and that groups I and III be treated as a single invention for examination.

In addition, as for the one aspect of the twofold requirement that was addressed with reference to groups I and III, the distinction between groups I and III is based on an assertion that the invention of group III has separate utility such as reinforcing devices for non-magnetic resonance imaging. As noted above, group III is defined by the language of claim 21 to be directed to a "reinforcement member for reinforcing an elongated intravascular magnetic resonance imaging device..." (emphasis added). Therefore, group III is defined in terms of serving for reinforcing a magnetic resonance imaging device, and as further defined by the language of the claims. The suggestion in the Office action that group III has separate utility for reinforcing devices for non-magnetic resonance imaging contradicts the claim language defining a "reinforcement member for reinforcing an elongated intravascular magnetic resonance imaging device..." The

applicant therefore requests that this contradictory assertion be reconsidered, and that group III be found not to have separate utility from group I. Correspondingly, the applicant respectfully requests that if the request for examining groups II and III together is denied, that in the alternative, groups I and III, comprising claims 1-10 and 21-28, be considered a single invention for purposes of examination in a future divisional application claiming priority from the present application.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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